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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86141386
Applicant	Integrated Embedded dba Barr Group
Applied for Mark	B G
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re Application of )  
)  
Integrated Embedded, DBA Barr Group )  
) EX PARTE APPEAL  
App. No.: 86/141,386 )  
)  
Trademark: B G )  
)  
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**APPLICANT’S APPEAL BRIEF**

I. INTRODUCTION

Applicant Integrated Embedded, DBA Barr Group, is the world’s most-trusted independent engineering consulting and training company with a focus specifically on embedded systems design. Barr Group offers its customers consulting services, training services, expert witnesses and product design services. To protect its valuable intellectual

property in the mark , Applicant sought to register the mark  in several classes for the services it offers under that mark for its actual use of the mark since at least as early as March 9, 2012. In its final refusal, the Office refused Applicant’s registration request in IC 045 on a single ground, likelihood of confusion with U.S. Registration No. 3073394 for Bracewell & Giuliani’s (a law firm) non-standard mark BG in a stylized form.

II. FACTUAL BACKGROUND

1. On December 11, 2013, Applicant applied to register the mark  in:
  - IC 041 for “IT training services; Training services in the field of design of computer hardware, integrated circuits, communications hardware and software and computer

networks for others;”

- IC 042 for “Engineering services in the field of design of computer hardware; integrated circuits, communications hardware and software and computer networks for others;”
- IC 045 for “Expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others.”

2. On March 20, 2014, an office action was issued refusing registration on the following five grounds:
  - a. Trademark Act Section 2 (d) – Likelihood of confusion refusal to register in International Class 045 because of an alleged likelihood of confusion with the BG mark in U.S. Registration No. 3073394;
  - b. Mark on Webpage Specimen Does Not Match Drawing;
  - c. Twitter Specimen Does Not Show Use with Services in International Class 42 and 45;
  - d. Clarification re Color Mark Required; and
  - e. Additional Fee Required – TEAS Plus Requirement Not Met.
3. On September 18, 2014, Applicant filed a response arguing against the likelihood of confusion refusal, again stating that color is not claimed and submitting a black and white sample of the mark, submitting substitute specimens for classes 042 and 045, submitting a more accurate description of the mark and submitting the required payment.
4. On October 14, 2014, an office action was issued stating that the specimens, drawing, mark description and fee requirements had been satisfied and making the

likelihood of confusion refusal final.

5. On April 14, 2015, Applicant filed a timely Notice of Appeal and Request for Reconsideration in IC 045.
6. On May 11, 2015, the Request for Reconsideration was denied and jurisdiction was restored to the Board.

Applicant respectfully requests reversal of the likelihood of confusion refusal for the reasons identified below.

### III. ARGUMENT

#### A. There is no likelihood of confusion between No. 3073394 for BG and the applied



The U.S. Patent & Trademark Office (“USPTO”) determines the issue of likelihood of confusion by focusing on the question of whether the purchasing public would mistakenly assume that the applicant’s goods originate from the same source as, or are associated with, the goods in the cited registrations. *Paula Payne Prods. Co. v. Johnson Publ ’g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). The USPTO makes that determination on a case-by-case basis. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1084, 56 USPQ 2d 1471, 1474 (Fed. Cir. 2000). The "marks must be viewed 'in their entirety,' and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design." *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012). In making that determination, the USPTO is aided by application of the factors set out in *In re EI du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Those factors are:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression;

(2) The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use;

(3) The similarity or dissimilarity of established, likely-to-continue trade channels;

(4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;

(5) The fame of the prior mark;

(6) The number and nature of similar marks in use on similar goods;

(7) The nature and extent of any actual confusion;

(8) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion;

(9) The variety of goods on which a mark is or is not used;

(10) The market interface between the applicant and the owner of a prior mark;

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods;

(12) The extent of potential confusion;

(13) Any other established fact probative of the effect of use.

*Id.* at 1361, 177 USPQ at 567. Not all of the DuPont factors may be relevant or of equal weight in a given case, and "any one of the factors may control a particular case," *In re Dixie Rests, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997). The "ultimate conclusion nonetheless must rest on consideration of the marks in total." *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012).

In considering the issue of likelihood of confusion, it is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof that is important.

*Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 US 538-545-46 (1920). This is known

as the Anti-Dissection Rule. McCarthy on Trademarks, Revision § 23:41, page 23-123. Whether there are both similarities and differences between marks, these must be weighed against one another to see which predominate. *Price Candy Co. v. Gold Medal Candy Corp.*, 105 USPQ 266, 268 (C.C.P.A. 1955). In determining the question of likelihood of confusion, it is appropriate to give greater weight to the important or "dominant" parts of a composite mark for it is that which may make the greatest impression on the ordinary buyer. McCarthy on Trademarks, Revision § 23:42, page 23-127.

Thus, it is not a violation of the Anti-Dissection Rule to look at the parts of the composites to determine which parts are likely to make a greater or lesser impact on the ordinary buyer. *Id.* at § 23:44. Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term rather than a commonly used term as the source-indicating feature of the mark. TMEP §1207.01(b)(viii). Moreover, "a composite mark (consisting of both a word element and a design element) must be considered in its entirety, trademark law recognizes that the word portion is often more likely to be impressed upon a purchaser's memory because it is the word that purchasers use to request the goods and/or services. Therefore, the word portion is often accorded great weight in determining the likelihood of confusion." *Alzheimer's Found. of Am., Inc. v. Alzheimer's Diseases & Related Disorders Ass'n*, 795 F. Supp. 2d 458, 465 (S.D.N.Y. 2011). However, the Federal Circuit has also cautioned that "there is no general rule that the letter portion of the mark will form the dominant portion of the mark. Marks, therefore must be considered on a case-by-case basis." *In re Viterra Inc.*, 671 F.3d 1358, 1362-63 (Fed. Cir. 2012).

**I. Here There Is No Likelihood Of Confusion With The Cited Registration in IC 045**

In applying the factors above, Applicant submits that the trademarks are clearly distinguishable for at least the following reasons: 1) the marks are dissimilar in their entireties as to

appearance, connotation and commercial impression; 2) the dissimilarity and nature of the goods; 3) the purchasers of these products are careful, sophisticated purchasers rather than "impulse buyers"; 4) the lack of fame of the prior mark, 5) the number and nature of similar marks in use on similar goods, 6) the lack of any evidence of any actual confusion; 7) the length of time during and the conditions under which there has been concurrent use without any evidence of actual confusion; and 8) the limited extent of potential confusion.

A. The Section 2(d) Refusal over U.S. Registration No. 3,073,394 in IC045 Should be Withdrawn



1. The Overall Commercial Impressions of the Applied for Mark  is Different From the Mark in Registration No. 3,073,394

a. The '394 Registration - Registration No. 3,073,394 (the "'394 Registration") is not a standard character mark, but rather a stylized mark with the text of the '394 Registration consisting of the *capital* letters BG where the upper portion of the *capital* G passes through the lower circular portion of the *capital* B. The '394 Registration is owned by Bracewell & Giuliani LLP, a law firm.



b. Mark Applicant has Applied For - Applicant's applied for mark  is a stylized mark consisting of a box including the right portion of a capital letter B (as opposed to the entire B) on the far left and a portion of the *small* letter g (as opposed to the entire g) on the right top corner of the left section of the rectangular box. The applied for mark does not include an entire capital B (but only the right hand portion of the B) and does not include any portion of a capital G. Rather the applied for mark only includes the left hand portion of a small letter g.

c. The Overall Commercial Impressions Are Different - Based on the above comparison, Applicant submits that the marks are dissimilar and that there is no likelihood of confusion between



the stylized BG of '394 Registration and Applicant's applied for mark . First, the words/text which appears in the two marks is different. The '304 Registration includes a complete *capital B* and a complete *capital G*, with the top portion of the G passing through (or hooked onto) the lower circular portion of the capital B. Applicant's applied-for mark only includes portions of a capital B and a small g, and there is space between the capital B and the small g – *i.e.*, the two letters are not



overlapping. Applicant's applied for mark  also includes a box which surrounds the portion of the capital B and the portion of the small g.

The Office Action mistakenly states that the “registered mark and the applied-for mark each consist of the letter “B” followed by the letter “G”.” This statement fails to acknowledge that: (1)



the g in the applied-for mark  is a small letter g; (2) the applied-for mark only includes a portion of a “B”; (3) the applied-for mark only includes a portion of a “g”; (4) the applied-for mark has a space between the portion of the B and the portion of the g; (5) the applied-for mark includes a box within which the portion of the B and the portion of the g appear; and (6) the registered mark has the upper portion of the G passing through the lower circular portion of the B.

A comparison of the marks in their entirety (as required) shows that there is very little similarity in the appearance, meaning, connotation or commercial impression of the marks. It cannot be said that these marks create the same overall impression, the impressions are completely different. It is black letter law that the marks must be compared in their entirety and that the comparison must include even the disclaimed portions of a mark. The mark as a whole must be considered in judging overall similarity between that mark and another mark. *Worthington Foods, Inc. v. Kellogg Co.*, 14 USPQ2d 1577, 1595 (S.D. Ohio 1990). Accordingly, Applicant respectfully

requests that the Likelihood of Confusion rejection in IC 045 be withdrawn. Even the trademark examining attorney has recognized that these marks are not identical in her denial of applicant's request for reconsideration. As stated above, applicant's applied for mark only includes portions of the letters B and g.

## 2. The Dissimilarity and Nature of the Goods and Trade Channels

- a. The '394 Registration - The '394 Registration is in IC 042 and is for legal services.
- b. Applicant's Applied for Mark – The only class of Applicant's applied for mark that has been refused under Section 2(d) (Likelihood of Confusion) is IC 045. The services provided by Applicant in IC 045 includes “Expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others.”
- c. The Nature of the Services are Different - Based on the above comparison, Applicant submits that the nature of the services are dissimilar and that there is no likelihood of confusion between the '394 Registration and Applicant's applied-for mark. The services affiliated with the registered mark are legal services. A review of the owner of the registered mark's (Bracewell & Giuliani) website shows that the firm does not appear to offer expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others – *i.e.*, the services associated with Applicant's applied-for mark in IC 045. Accordingly, Applicant submits that the nature of services are different and there is no likelihood of confusion between the registered mark and Applicant's applied for mark.

## 3. Purchasers are Careful and Sophisticated rather than "Impulse Buyers"

In its response to the first office action, Applicant argued that it is beyond dispute that companies and individuals who purchase the types of services related to Applicant's applied-for

mark are careful and sophisticated buyers as opposed to impulse buyers who purchase services without a careful analysis and examination. However, the office action stated that Applicant did not “offer any evidence in support of this argument.” Accordingly, Applicant submitted the April 13, 2015 Declaration of Michael Barr in Support of Applicant’s April 14, 2015 Request for Reconsideration After Final Office Action. In paragraph 6, Mr. Barr states “Barr Group’s customers and potential customers are very sophisticated. Our customers and potential customers typically have a bachelor’s of science degree in engineering and/or computer science plus decades of related work experience. Moreover, consulting services offered by Barr Group and purchased by its customers typically cost in excess of U.S. \$5,000. Barr Group’s customers and potential customers are not drawn from the general public or less sophisticated customers.” In paragraph 7, Mr. Barr identifies several attached charts which show the years of experience and primary job functions for their clients.

#### 4. The Lack of Fame of the '394 Registration

The Office Action does not argue that the mark of the '394 Registration is famous, or that it is entitled to any deference as a famous mark. Moreover, the Office Action fails to include any evidence that the '394 Registration is famous.

#### 5. The Number and Nature of Similar Marks in Use On Similar Goods

Applicant maintains that BG is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. A search on the USPTO's website for registered trademarks that include BG in the "Mark Punctuated/Word Mark" Field and the "Live/Dead Indicator" indicating "Live", identified 133 current "live" marks that include BG". Of these 46 are just for the mark BG. Also, of these 46 marks, 6 are in the same class as the '394 Registration - class 042 (including Registration Nos. 3893374; 3034480; 3814849; 1887647; 1878202; 1030422). These include:

Mark	Serial Number	Registration Number	In. Class(es)
BG	<a href="#">85492780</a>	<a href="#">4700109</a>	35
BG	<a href="#">85850659</a>	<a href="#">4625598</a>	41
BG	<a href="#">85978370</a>	<a href="#">4302893</a>	18
BG	<a href="#">85836068</a>	<a href="#">4486252</a>	28
BG	<a href="#">85822305</a>	<a href="#">4391788</a>	43
BG	<a href="#">85494414</a>	<a href="#">4384794</a>	25
BG	<a href="#">85459636</a>	<a href="#">4164466</a>	9
BG	<a href="#">85397054</a>	<a href="#">4118643</a>	36
BG	<a href="#">85342398</a>	<a href="#">4302066</a>	14
BG	<a href="#">85265318</a>	<a href="#">4081326</a>	25
BG	<a href="#">85124684</a>	<a href="#">3957467</a>	25
BG	<a href="#">85096908</a>	<a href="#">3995140</a>	25
BG	<a href="#">85093649</a>	<a href="#">3967939</a>	25
BG	<a href="#">85028037</a>	<a href="#">3893374</a>	42
BG	<a href="#">79125548</a>	<a href="#">4582166</a>	5,8,9,11,13,16,18,20,21,22,25 &28
BG	<a href="#">79138581</a>	<a href="#">4553987</a>	7, 40
BG	<a href="#">79138274</a>	<a href="#">4553979</a>	7, 40
BG	<a href="#">78599247</a>	<a href="#">3073394</a>	42
BG	<a href="#">78732620</a>	<a href="#">3139150</a>	12, 25
BG	<a href="#">78453524</a>	<a href="#">3366597</a>	9
BG	<a href="#">78404680</a>	<a href="#">3034480</a>	42
BG	<a href="#">77711640</a>	<a href="#">3708278</a>	41
BG	<a href="#">77746459</a>	<a href="#">3921604</a>	25
BG	<a href="#">77976239</a>	<a href="#">3647559</a>	35
BG	<a href="#">77956911</a>	<a href="#">4040210</a>	35, 36
BG	<a href="#">77931316</a>	<a href="#">3845104</a>	14
BG	<a href="#">77847309</a>	<a href="#">3878696</a>	15, 20, 21
BG	<a href="#">77736939</a>	<a href="#">3884793</a>	25
BG	<a href="#">77723800</a>	<a href="#">3798456</a>	35, 39
BG	<a href="#">77672831</a>	<a href="#">3672939</a>	30, 41
BG	<a href="#">77027115</a>	<a href="#">3328360</a>	8, 19, 21, 35
BG	<a href="#">76977007</a>	<a href="#">2996884</a>	25, 35
BG	<a href="#">76685299</a>	<a href="#">3512982</a>	18
BG	<a href="#">76575132</a>	<a href="#">3107292</a>	6
BG	<a href="#">76559066</a>	<a href="#">2984562</a>	41
BG	<a href="#">76334144</a>	<a href="#">3585065</a>	16
BG	<a href="#">75983682</a>	<a href="#">3814849</a>	37, 39, 42
BG	<a href="#">75302152</a>	<a href="#">3849137</a>	4
BG	<a href="#">75252593</a>	<a href="#">2142581</a>	31
BG	<a href="#">74519864</a>	<a href="#">1887647</a>	42
BG	<a href="#">74222614</a>	<a href="#">1878202</a>	42
BG	<a href="#">73041442</a>	<a href="#">1030422</a>	42
BG	<a href="#">73839801</a>	<a href="#">1611351</a>	6

BG	<a href="#">73706905</a>	<a href="#">1542451</a>	1, 3, 4
BG	<a href="#">73526553</a>	<a href="#">1423371</a>	1, 3, 4
BG	<a href="#">71327723</a>	<a href="#">0298486</a>	25

Copies of the above were included with Applicant's Request for Reconsideration so that they are references properly of record and will be considered by the examiner.

In light of the number and nature of other similar marks which include the term "BG", Applicant's applied for mark should be registered.

The trademark examining attorney has stated that each of these is entitled to "little weight in determining the strength of the mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them." However, each of these, including the 6 others in class 042, include specimens of use indicating that they are currently being used in the market and being seen by consumers.

6. The Lack of Any Evidence of Any Actual Confusion

Applicant is unaware of any actual confusion between Applicant's use of the applied-for mark since at least as early as March 9, 2012 and the mark of the '394 Registration, which has allegedly been used since at least as early as March 31, 2005. While the Office Action alleges that this is not a relevant standard, the fact that these two marks have been used simultaneously for more than three years without Applicant being informed of any actual confusion is indicative that there is no likelihood of confusion between the two marks.

7. The Length of Time During and the Conditions Under Which There Has Been Concurrent Use Without Any Evidence of Actual Confusion

The '394 Registration claims a first use and a first use in commerce of March 31, 2005. Applicant's first use and first use in commerce of its applied for mark was at least as early as March 9, 2012. Despite over three years of concurrent use of the two marks, Applicant is unaware of any evidence of actual confusion between the two marks. Again, this fact is indicative that there is no

likelihood of confusion between the two marks.

8. The Limited Extent of Potential Confusion

As previously stated, Applicant is unaware of any actual confusion between the mark Applicant has applied for and the '394 Registration. Moreover, based on the dissimilarities in the offered services and the sophistication of the purchasers, Applicant believes there is very little chance of potential confusion between the '394 Registration and the mark Applicant has applied for.

Accordingly, Applicant requests that the Examiner remove the refusal allegedly based on likelihood of confusion over the '394 Registration.

IV. CONCLUSION

Applicant has demonstrated that there is no likelihood of confusion of the applied-for mark



in IC 045 with U.S. Registration No. 3,073,394 for the stylized mark BG in IC 045.

In view of the foregoing, it is respectfully requested that the Board reverse the refusal

and allow the applied-for-mark  to proceed to publication.

Dated: July 10, 2015

Respectfully submitted,

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